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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,556	08/24/2000	Jakob Scharf	194344US0	2549

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EXAMINER

TOOMER, CECILIA D

ART UNIT PAPER NUMBER

1714

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,556

Examiner

Cephia D. Toomer

Applicant(s)

SCHARF ET AL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,11-26,28-51 and 53-67 is/are pending in the application.
- 4a) Of the above claim(s) 51-61 and 64-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,11-14,16,18,19,21-26,28,41,43,45,46,48-50,62 and 63 is/are rejected.
- 7) ☐ Claim(s) 15,17,20,42,44,47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to the amendment filed September 24, 2002 in which claims 3-10, 27 and 52 were canceled, claims 1, 11, 26, 32-45, 47-48, 51 and 58 were amended and claims 62-67 were added.

Election/Restrictions

1. Applicant's election of Group I in Paper No. 6 (telephone election) and Paper No. 7 (response to the Office action) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 51-61 are withdrawn from further consideration as set forth in the previous Office action and by applicant's affirmation of claims 1-50, as set forth at page 10 of the response to the Office action. Since claims 64-67 are directed to the same process of claims 51 and 58, claims 64-67 are also withdrawn from consideration. The restriction is FINAL.
2. It should be noted that the original filed specification does not support the subject matter added to claims 51 and 58, and presented in claims 64-67.
3. The allowable of the claims is withdrawn in view of a broader interpretation of the prior art.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5 Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 is rejected because there is no antecedent support in claim 31 for "said hydroxyalkyl (meth) acrylate."

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 11-13, 22-24, 26, 28-40, 49-50, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halle (6,020,385).

Halle teaches microencapsulated monomers containing a polymerization inhibitor (see abstract). Halle defines monomers as any compound with one polymerizable C=C bond. The monomers include, for example, styrene, vinyltoluene, alpha methylstyrene, chlorostyrene, (meth) acrylic acid or esters, (meth) acrylamide, etc. (see col. 1, lines 46-63). The monomers may be admixed with a solvent, such as hexane, methyl ethyl ketone, etc. (see col. 2, lines 62-67). The polymerization inhibitor may include N, N-diethyl hydroxylamine or N-nitrosophenylhydroxylamine or the ammonium or aluminum salt thereof (see col. 3, lines 14-41). The inhibitor is present in the composition in an amount from 10 to 1000 ppm (see col. 3, lines 57-65). The composition also contains

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phosphate buffers (col. 4, lines 29-34). Halle teaches the limitations of the claims other than the difference that is discussed below.

In the first aspect, Halle differs from the claims in that he does not teach the specific monomers of the claims. However, Halle's general teaching of monomers containing C=C bonds is sufficient to render Applicant's monomers prima facie obvious. It would be reasonable to expect that any compound which meets this limitation, (C=C bond), would be stabilized against premature polymerization.

In the second aspect, Halle differs from the claims in that he does not specifically teach a monomer composition wherein both inhibitors are present. However, it would have been obvious to one of ordinary skill in the art to have used both inhibitors because it is prima facie obvious to combine two components each which is taught by the prior art to be useful for the same purpose, in order to form a composition to be used for the very same purpose.

Claims 1, 2, 11, 13, 14, 16, 18-19, 21, 24-26, 29-39, 41, 43, 45, 46, 48, 50, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 467850.

EP teaches a monomer composition comprising an ethylenically unsaturated monomer and polymerization inhibitors (see abstract). The inhibitors are phenothiazine, and N, N- diethylhydroxylamine in a ratio of 1:10 to 1000:1 (see page 5, lines 6-12). The monomers are any having at least one carbon-carbon double bond capable of undergoing free radical induced polymerization and include, for example, styrene, alpha-styrene, meth (acrylic) acid and esters, 2-hydroxyethyl (meth) acrylate (see page 5, lines 16-27, 40-45). EP teaches that the composition may also contain additional

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inhibitors such as nitrophenylhydroxylamine, catechol, and alkylated phenols (see page 5, lines 47-50). The composition may also contain UV absorbers and stabilizers (see page 5, lines 51-53, figure D, page 6). EP teaches the limitations of the claims other than the difference that is discussed below

In the first aspect, EP differs from the claims in that it does not teach the specific monomers of the claims. However, EP's general teaching of any monomers having at least one carbon-carbon double bond capable of undergoing free radical induced polymerization is sufficient to render Applicant's monomers *prima facie* obvious. It would be reasonable to expect that any compound which meets this limitation, (carbon-carbon double bond), would be stabilized against premature polymerization.

In the second aspect, EP differs from the claims in that it does not specifically teach a monomer composition wherein all of the claimed inhibitors are present. However, it would have been obvious to one of ordinary skill in the art to have used more than one inhibitor because it is *prima facie* obvious to combine two or more components, each of which is taught by the prior art to be useful for the same purpose, in order to form a composition to be used for the very same purpose.

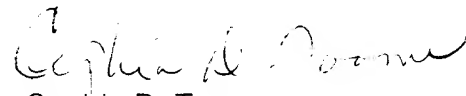
Claims 15, 17, 20, 42, 44, and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Cephia D. Toomer
Primary Examiner
Art Unit 1714

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December 12, 2002